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| 09/777,212      | 02/05/2001  | Kenneth S. Wyker     | 2503/1              | 3030             |

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EXAMINER

DURAN, ARTHUR D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3622

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/777,212

Applicant(s)

WYKER, KENNETH S.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
JEFFREY D. CARLSON  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-41 have been examined.

#### *Response to Amendment*

2. The After-Final Request for Reconsideration filed on 12/27/04 has been received. The arguments concerning the improper First Action Final after an RCE were convincing. However, the Applicant has added new arguments concerning the rejection. Therefore, this new action has been sent out and is fully responsive to the Applicant's Arguments in the Applicant's Request for Reconsideration. Applicant's arguments are addressed in the Response to Arguments section below.

The Amendment filed on 12/27/04 is insufficient to overcome the Deaton and Kepecs reference.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-5, 7-21, 23-31, 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (5,687,322) in view of Kepecs (6,330,543).

Claim 1, 2, 13, 14, 19, 29, 39: Deaton discloses a business method for influencing consumer purchase of retail sales items, comprising the steps of:

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- (a) creating an electronic consumer database for each of a plurality of retail stores, the database indicating a purchase history of items purchased by consumers at the retail store (col 73, lines 30-37);
- (b) determining when a common item is offered for sale by each of the retail stores at a reduced retail sales price (col 73, lines 30-35; col 90, lines 6-26; col 74, lines 17-27), the reduced retail sales price being effective for a promotion period determined by each retail store (col 102, line 65-col 103, line 5; col 106, lines 37-50); and
- (c) based on the promotion periods for the common item at respective retail stores and the purchase history of the consumers, offering the common item to a predetermined select group of consumers with a price discount established by a manufacturer of the common item, the manufacturer price discount resulting in a target sales price adapted to influence purchase by the consumer (col 74, line 17-col 75, line 8).

Deaton further discloses offering a complementary item (col 74, lines 3-17).

Deaton further discloses the price discount being valid exclusively during the promotion period for each retail store (col 102, line 65-col 103, line 5; col 106, lines 37-50), and resulting in a target sales price less than the reduced retail sales price (col 90, lines 6-26; col 74, lines 17-27; col 74, lines 38-48; col 71, lines 10-25; col 160, lines 50-60).

Deaton further discloses purchasing an item from a manufacturer for resale at a retail store (col 74, lines 20-25), establishing a retail sales price for the item (col 74, line 65-col 75, line 5; col 74, lines 22-25; col 90, lines 6-26; col 74, lines 17-27).

Deaton further discloses the manufacturer or retailer can set price discounts (col 74, line 21-27) based upon customer history (col 74, line 24-28).

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Deaton does not explicitly disclose that the price discounts can be set based upon the interaction of promotions between the manufacturer and retailer and optimized from the manufacturer's perspective.

However, Kepecs discloses a DAP computer performing price and promotion calculation functions for a manufacturer or retailer (col 8, lines 40-50; Fig. 3).

Kepecs further discloses targeting a user and a retailer and/or producer/manufacturer providing pricing promotions (col 2, lines 29-35).

Kepecs further discloses that both the retailer and/or manufacturer provide pricing promotions (col 2, lines 44-52; col 4, lines 35-40).

Kepecs further discloses that the producer and retailer obtain useful information to precisely and effectively target promotional offers (col 4, lines 62-65).

Kepecs further discloses targeting promotions to select customers based on customer history, retailer information, manufacturer promotions, advertising history, availability of and user interaction with other promotions (col 6, line 61-col 7, line 10).

Kepecs further discloses providing a discounter promotion instructions based upon the interaction of promotions between the discounter and the retailer (col 7, lines 30-44).

Kepecs further discloses that the discounter can be a manufacturer or retailer (col 5, lines 30-35).

Kepecs further discloses the manufacturer utilizing the DAP to target pricing and promotions (col 7, lines 26-31).

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Kepecs further discloses that promotions information includes promotion period (col 17, lines 5-10; col 14, lines 45-50; col 12, lines 57-62; col 11, lines 25-30; col 10, lines 28-33; col 5, lines 37-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Kepecs offering of promotions based upon the interaction of manufacturer and retailer promotions and optimized from a manufacturer's perspective to Deaton's manufacturer and retailer promotions that interact and are optimized. One would have been motivated to do this in order for the manufacturer to be able to obtain pertinent information to precisely and effectively target promotional offers.

Additionally, Deaton discloses that both single and multiple stores can be involved (col 3, lines 20-27; col 95, lines 1-6), that promotions can be targeted at a particular store (col 63, line 55-col 64, line 5), that promotions can be targeted for certain time periods (col 73, line 61-col 74, line 17; col 94, lines 20-47; col 102, lines 27-40; col 102, line 53-col 103, line 5), and that promotions can be controlled or modified in a variety of manners based on a variety of factors (col 103 line 5-47).

Deaton further discloses both manufacturer and retailer promotions (col 74, lines 21-25), and manufacturer and retailer discounts on the same product and that the discounts can be coordinated in order to provide the optimal total discount in regards to the goals of the manufacturer and the retailer (col 105, lines 10-34).

Kepecs further discloses that the promotions are targeted to a particular store or stores (col 9, lines 12-15; col 3, lines 5-15) that there can be tracked and monitored promotion periods for discounts (col 10, lines 25-31; col 17, lines 6-12)

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Kepecs further discloses offering manufacturer and retailer discounts and that the discounts can be on the same products (col 2, lines 45-51), that manufacturer and retailer discounts can be coordinated and optimized (col 3, line 59-col 4, line 11), that manufacturer promotion information and retailer cost and price information is known, coordinated, and optimized (col 6, line 60-col 7, line 10) including considering the effects of manufacturer promotions and interaction with other promotions (col 13, line 65-col 14, line 12).

Kepecs further discloses that a discounter can be a retailer or a manufacturer (col 5, line 30-35; col 8, lines 40-45) and that manufacturer discounts can be determined or optimized based upon the discounts being offered by another discounter (col 7, lines 26-43).

Claim 3: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses that the manufacturer's price discount is offered at each of the retail stores outside of the promotion period for each retail store (col 114, lines 15-19; col 160, lines 50-60).

Claim 4, 20, 30: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses providing a personalized saving sheet to each consumer of the select group of consumers indicating the target sales price of the item (col 74, lines 59-65; col 160, lines 50-60).

Claim 5, 21, 31: Deaton and Kepecs disclose a business method according to claim 4, and Deaton further discloses that the personalized saving sheet indicates a total savings to the consumer when purchasing the item at the retail store (col 74, line 64- col 75, line 5).

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Claim 7, 23, 33: Deaton and Kepecs disclose a business method according to claim 4, and Deaton comprising presenting the personalized saving sheet to the consumer at the retail store (col 73, lines 4-14).

Claim 8, 24, 34, 40: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses that the item is sold by the retail store for the target sales price only when purchased in quantities of two or more (col 144, lines 14-16; col 7, lines 37-41).

Claim 9, 25, 35, 41: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses that the item is offered for sale at the target sales price for only one day of the promotion period (col 106, lines 37-50).

Claim 10, 26, 36: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses that the item is one that the consumer has a history of purchasing at the retail store (col 74, lines 11-15; col 73, lines 49-57).

Claim 11, 27, 37: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses that the item is one that the consumer has no history of purchasing at the retail store (col 74, lines 10-12; col 70, lines 3-10).

Claim 12, 28, 38: Deaton and Kepecs disclose a business method according to claim 1, and Deaton further discloses automatically applying the target sales price to the item at a point of sale (col 73, lines 4-14).

Claim 15: Deaton and Kepecs disclose a business method according to claim 13, and Deaton further discloses that the complementary item is offered for sale at the target sales price for only one day of the promotion period (col 74, lines 8-10; col 106, lines 37-50). Deaton



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further implies that the coupon targeting techniques also apply to the coupon for the complementary item (col 74, lines 7-8; col 74, lines 14-17).

Claim 16: Deaton and Kepecs disclose a business method according to claim 13, and Deaton further discloses that the complementary item is one that the consumer has a history of purchasing at the retail store (col 74, lines 8-10; col 74, lines 11-15). Deaton further implies that the coupon targeting techniques also apply to the coupon for the complementary item (col 74, lines 7-8; col 74, lines 14-17).

Claim 17: Deaton and Kepecs disclose a business method according to claim 13, and Deaton further discloses that the complementary item is one that the consumer has no history of purchasing at the retail store (col 74, lines 8-10; col 74, lines 10-12). Deaton further implies that the coupon targeting techniques also apply to the coupon for the complementary item (col 74, lines 7-8; col 74, lines 14-17).

Claim 18: Deaton and Kepecs disclose a business method according to claim 13, and Deaton further discloses comprising automatically applying the target sales price to the complementary item at a point of sale (col 74, lines 8-10; col 73, lines 4-14). Deaton further implies that the coupon targeting techniques also apply to the coupon for the complementary item (col 74, lines 7-8; col 74, lines 14-17).

4. Claim 6, 22, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (5,687,322) in view of Kepecs (6,330,543) in further view of Barnett (6,321,208).

Claim 6, 22, 32: Deaton and Kepecs discloses a business method according to claim 4. Deaton further discloses sending the personalized saving sheet to the consumer prior to the

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consumer entering the retail store (col 74, lines 53-65) and electronic savings sheets (col 73, lines 4-14).

Additionally, the smart card with coupons that Deaton gives the customer at the cash register is an electronic savings sheet given to the customer prior to the customer next entering the retail store.

Deaton does not explicitly disclose that the electronic savings sheet is sent to the customer prior to the customer entering the retail store at all.

However, Barnett discloses electronically sending the personalized saving sheet to the consumer prior to the consumer entering the retail store (Fig. 1; col 5, lines 20-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's electronically sent saving sheet to the consumer to Deaton's electronic coupons and Deaton's coupons sent to the consumer. One would have been motivated to do this because electronically sent coupons are convenient to many users.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-41 have been considered but are not found persuasive.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Please also note that the additional citations added below have also been added to the rejection above.

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Deaton further discloses that both single and multiple stores can be involved (col 3, lines 20-27; col 95, lines 1-6), that promotions can be targeted at a particular store (col 63, line 55-col 64, line 5), that promotions can be targeted for certain time periods (col 73, line 61-col 74, line 17; col 94, lines 20-47; col 102, lines 27-40; col 102, line 53-col 103, line 5), and that promotions can be controlled or modified in a variety of manners based on a variety of factors (col 103 line 5-47).

Deaton further discloses both manufacturer and retailer promotions (col 74, lines 21-25), and manufacturer and retailer discounts on the same product and that the discounts can be coordinated in order to provide the optimal total discount in regards to the goals of the manufacturer and the retailer (col 105, lines 10-34).

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Kepecs further discloses that a discounter can be a retailer or a manufacturer (col 5, line 30-35; col 8, lines 40-45) and that manufacturer discounts can be determined or optimized based upon the discounts being offered by another discounter (col 7, lines 26-43).

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Additionally, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Conclusion*

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AD

1/31/05

  
JEFFREY D. CARLSON  
PRIMARY EXAMINER